

REMARKS

The Office Communication states that the reply filed on January 3, 2005 is not fully responsive to the Office Action mailed on June 28, 2004 because the reply cancelled claims drawn to the elected invention and only presented claims drawn to a non-elected invention. The Office Communication also states that claim 14 as originally presented, searched and examined was directed to a species where the second phase was a three dimensional network, but is now directed to a "mutually exclusive limitations/species" "having the second phase as particles." Consequentially, it is alleged that:

It would be an unreasonable burden on the Office to now search for this mutually exclusive specie. Furthermore, as per the first rejection by the Office, the invention of original claim 14 had no special technical feature. Therefore the species of present claim 14 does not share a special technical feature with the originally presented, searched and examined claims. Therefore there is no unity of invention.

As a result, claims 14-16, 18 and 19 have been withdrawn from consideration as being directed to a non-elected invention.

It is noted that this Office Communication has been issued by a new Examiner, Mr. John Hoffman. The Office Action mailed on June 28, 2004, to which the allegedly non-responsive reply was directed, was issued by Examiner Christopher A. Fiorilla. Examiner Fiorilla issued a restriction requirement on April 6, 2004 stating that the application contained two (2) groups of inventions, i.e., Group I: claims 1-13, drawn to a method and Group II: claims 14-21, drawn to a composite. In response thereto, the Group II invention of claims 14-21, drawn to a composite, was provisionally elected for prosecution on the merits. Claim 14 recited:

A composite ceramic article comprising;
a first phase of ceramic material; and
a second phase of ceramic material;
wherein the first and second phases form three dimensional interconnected networks of each phase.

Claim 17 recited:

The composite ceramic product according to claim 14, wherein the second phase includes particles which are distributed along grain boundaries of the first phase.

In paragraph 1 of the Office Action mailed on June 28, 2004, Examiner Fiorilla acknowledged the election of claims 14-21.

In paragraph 2 of the Office Action mailed on June 28, 2004, Examiner Fiorilla withdrew non-elected claims 1-13 from consideration.

In paragraphs 3-10 of the Office Action mailed on June 28, 2004, Examiner Fiorilla addressed elected claims 14-21 on the merits.

In paragraph 3 of the Office Action mailed on June 28, 2004, Examiner Fiorilla stated that claims 17-19 were objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. The objection stated that "[a]pplicant is required to...rewrite the claim(s) in independent form."

Thus, Examiner Fiorilla has already examined what Examiner Hoffman considers to be a "mutually exclusive limitations/species" i.e., the alleged species of dependent claim 17 "having the second phase as particles." Moreover, the reply filed on January 3, 2005, contrary to what is stated in the present Office Communication, only presented claims drawn to an elected invention for consideration by the Examiner, i.e., the invention of claims 14-21, which were examined and reported on in the Office Action of June 28, 2004 by Examiner Fiorilla.

Furthermore, the January 3, 2005 reply complied with all requirements of the June 28, 2005 Office action, especially, the requirement of paragraph 3 thereof, i.e., claim 17 was essentially rewritten in independent form by amending independent claim 14 to include the limitations of claim 17:

A composite ceramic article comprising;
a first phase of ceramic material; and
a second phase of ceramic material;
wherein the first and second phases form three dimensional
interconnected networks of each phase the first and second phases,
the second phase including particles which are distributed along
grain boundaries of the first phase.

The subject matter of amended claim 14 is discussed in the paragraph starting on page 9 extending to page 10.

In view of the foregoing, the reply filed on January 3, 2005 only presented elected claims directed to an alleged species already considered by the Patent Office, and the reply fully responded to the Office Action of June 28, 2005. Hence, the conclusion that the January 3, 2005 reply is non-responsive, and the withdrawal of claims 14-16, 18 and 19 from consideration by

Examiner Hoffman, as not being directed to an elected invention, is improper. It is, therefore, respectfully requested that claims 14-16, 18 and 19 as amended in the reply filed on January 3, 2005 be reinstated, and that the reply filed on January 3, 2005 be considered.

The Examiner is respectfully urged to contact the undersigned attorney at his number listed below if he has any questions.

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17, which are associated with this communication, or credit any overpayment to Deposit Account No. 50-2061.

Respectfully submitted,



PAUL A. SCHWARZ
PTO Reg. No. 37,577

Duane Morris LLP
P.O. Box 5203
Princeton, New Jersey 08543-5203
Tel: (609) 631-2446
Fax: (609) 631-2401